

FROM

(MON) 3. 31' 03 22:25/ST. 22:24/NO. 4261284685 P. 1

FAX RECEIVED

APR 01 2003

GROUP 3600

SCHULTE ROTH & ZABEL LLP

919 Third Avenue
New York, NY 10022
(212) 756-2000
fax (212) 593-5955

www.srz.com

Official

FACSIMILE
PLEASE DISTRIBUTE TO ALL LISTED PERSONS

To	Company	Fax No.	Confirmation No.
Examiner Pedro Kanof	Group 3628	703-872-9327	703 308 9552

FROM:	David E. Boundy	DATE:	March 31, 2003
DIRECT DIAL:	(212) 756-2522	Number of Pages:	
FILE NO.:	57634.3		

Applicant(s): Douglas G. Lowenstein, et al.

Serial No.: 09/611,548

Art Unit: 3628

Filed: July 7, 2000

Examiner: Pedro Kanof

Title: FINANCING OF TENANT IMPROVEMENTS

3603

AFTER FINAL – EXPEDITED PROCEDURE

I hereby certify that the attached

- This FAX cover sheet
- Change of Correspondence Address – Second Request
- Request for Withdrawal of Finality
- Response to Office Action of January 29, 2003, including Appendices 1 and 2
- Information Disclosure Statement

along with any paper(s) referred to as being attached or enclosed) are being transmitted by facsimile on March 31, 2003 to the Commissioner for Patents, Box AF, Washington, D.C. 20231.

Dated: March 31, 2003

By: 

David E. Boundy
Registration No. 36,461

THIS INFORMATION CONTAINED IN THIS MESSAGE IS INTENDED ONLY FOR THE USE OF THE INDIVIDUAL OR ENTITY NAMED ABOVE. IF THE READER OF THIS MESSAGE IS NOT THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY DISSEMINATION, DISTRIBUTION OR COPYING OF THIS COMMUNICATION IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS COMMUNICATION IN ERROR, PLEASE IMMEDIATELY NOTIFY US BY TELEPHONE, AND RETURN THE ORIGINAL MESSAGE TO US AT THE ABOVE ADDRESS VIA THE U.S. POSTAL SERVICE. THANK YOU.

For incomplete transmission please call (212) 756-2000 ext.6076

9404083.2

Received from < > at 3/31/03 10:22:07 PM [Eastern Standard Time]

FROM

(MON) 3. 31 ' 03 22:25/ST. 22:24/NO. 4261294695 P 3

#126.8
4.4.03

PATENT

DOCKET NO. 57634.3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit: 3628

Examiner: Pedro Kanof

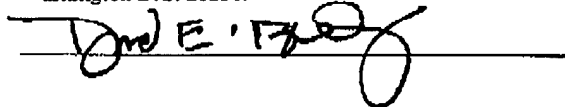
Serial No.: 09/611,548

Filed: July 7, 2000

Applicant(s): Douglas G. Lowenstein, et al.

Title: FINANCING OF TENANT IMPROVEMENTS

I certify that this correspondence, along with any documents referred to therein, is being transmitted by facsimile on March 31, 2003 to The Commissioner for Patents, Box AF, Washington D.C. 20231.



COMMISSIONER FOR PATENTS
Box AF
Washington D.C. 20231

REQUEST FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION

Pursuant to MPEP § 706.07(c) and (d), Applicant requests that the premature finality of the Action of January 29, 2003 be withdrawn, that the Response to Office Action be entered as of right, and that the arguments in that Response be given the examiner's full consideration.

I. There are a number of defects in the second Office Action that prevent final rejection

The Response to Office Action filed herewith notes a number of defects in the second Office Action that render final rejection premature, as noted:

- improper reliance on Official Notice – sections III.E (page 7), section VII.B (page 16), and section VIII.B (page 18)
- incomplete showing of inherency - section III.B (page 5)
- incomplete showing of *prima facie* obviousness – section XII (page 24)

An incomplete or formally improper rejection cannot mature into a final rejection. For the reasons discussed in the Response to Office Action, finality should be withdrawn.

II. New grounds of rejection of unamended claims are raised in the second Office Action – accordingly, final rejection is premature

MPEP § 706.07 and § 706.07(a) instructs that an Action may not be made final when it introduces a new ground of rejection of unamended claims.

FROM

Application Serial NO. 09/011,548
Atty. Docket No. 57634.3

(MON) 3. 31' 03 22:26/ST. 22:24/NO. 4261294695 P 4

First, the second Office Action (January 2003) raises a number of rejections under § 102(a). In contrast, no such rejections were raised in the first Office Action (January 2002) – the first Action only addressed § 102(e) issues. A number of claims now purportedly rejected under § 102(a) were not amended in Applicant's papers.

Second, at section III.D (page 6), the accompanying Response to Office action discusses a shift in the grounds of rejection of claims 1, 2 and 60, from express teaching to inherency. This is a new ground of rejection. These claims are unamended. Final rejection after this shift is premature.

These are new grounds of rejection not necessitated by Applicant's amendment. Thus final rejection is premature.

III. Conclusion

For these reasons, the finality of the Action of January 29, 2003 should be withdrawn, the Response filed herewith should be entered as of right (even without a showing of reasons under Rule 116), and the Remarks therein should be given the Examiner's full consideration.

It is believed that this paper occasions no fee. Kindly charge any fee due to Deposit Account 50-0675, Order No. 57634.3.

Respectfully submitted,

SCHULTE ROTH & ZABEL, LLP

Dated: March 31, 2003

By: 

David E. Boundy

Registration No. 36,461

Mailing Address:
SCHULTE ROTH & ZABEL, LLP
919 Third Avenue
New York, New York 10022
(212) 756-2000
(212) 593-5955 Telecopier